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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,690	08/06/1999	MASATO TAKEUCHI	49233-(1117)	7128

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EXAMINER

WON, YOUNG N

ART UNIT	PAPER NUMBER
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2155

19

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/369,690

Applicant(s)

TAKEUCHI ET AL.

Examiner

Young N Won

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 17. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-7 are pending in this action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso (US Pat No.6085201 A).

As per claims 1-7, Tso teaches of an information processing device (see col.1, lines 4-7) and a storage medium carrying program readable by a computer (see col.3,

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lines 21-28), which causes the computer to transmit and receive electronic mail over a transmission line, comprising of: a screen (see Fig.1, #2) for displaying received electronic mail to a user (see col.4, lines 5-12); a memory means (see Fig.2, #4 and col.3, line 46) for storing answer examples for a reply mail (see col.4, lines 23-24 and col.5, lines 7-9); a content selecting means for presenting a content of received mail and requiring a user to pick therefrom at least one or more portions of contents necessary for preparing a reply to the received mail (see Fig.3, #231, #233, & #235; col.4, lines 31-36; col.5, lines 49-53; and col.6, line 66 to col.7, line 13); an candidate answer message selecting means for requiring a user to select any of the answer examples stored by the memory means (see Fig.3 and col.5, lines 42-48 & 51-60); an answer example adding means for additionally storing the answer example prepared by the reply example preparing means into the memory means (see col.6, lines 59-63); and a reply-mail preparing means for preparing a reply mail by coupling at least one or more portions of contents selected by the contents selecting means with answer examples selected by the answer example selecting means (see Fig.3; Fig.4; and col.6, lines 66-67 to col.7, lines 1-13). Tso does not explicitly teach setting the sender of the received mail as an addressee of the reply mail and the receiver of the received mail as an addresser of the reply mail, although Tso does teach that one of the response actions can be responding to the writer (see col.4 lines 31-34). Nonetheless, it would be inherit that such a response would entail setting the sender of the received mail as an addressee, to, or the like and the receiver of the received mail as the addresser, from, or the like, as is well known and currently applied in all email systems.

### ***Response to Remarks***

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "used **directly** in a reply mail") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim language "necessary for **preparing**", suggests otherwise. Furthermore, Tso teaches this argument: "The present invention provides context-sensitive template engine that helps users compose and/or reply to e-mail message using minimal keyboard access. Given an input text passage, such as a portion of a partially-composed outgoing text message **or a portion of a received text message**, the template engine..." (See col.2, lines 59-67). The claim language must be clear and precise so as to convey to one of ordinary skill in the art that the teachings of the reference (Tso) cannot perform the function of the claimed invention.

Although, Tso teaches of a template generated by a template engine, he also teaches that this template engine generates a "context-sensitive" text message corresponding to an *input text string* (see abstract: 1<sup>st</sup> sentence). One of ordinary skill in the art would argue that the generated text message could in fact contain actual contents directly received from the input text string. One of ordinary skill could also

argue that by means of selecting contents from an incoming message and adding the selected content into a reply message is merely a performance of "cut and paste" which is well known and performed quite easily within a word processor.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won

August 13, 2003

  
HOSAIN T. ALAM  
PRIMARY EXAMINER